

### **REMARKS**

In response to the Office Action dated October 7, 2003, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

By the foregoing amendment, claims 11, 14, 15, 25, 26, and 29-31 have been amended. Accordingly, claims 1-32 will be pending herein upon entry of this Amendment.

In the Office Action, claim 29 was objected to because of informalities. Claims 11-16 and 25-31 were rejected under 35 U.S.C. § 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 14 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 11 and 25-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Northington et al. (U.S. Patent No. 6,128,602, hereinafter "Northington"). Claims 1-10 and 12-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Northington in view of Rigole (U.S. Application No. 2001/0049632A1).

Applicants note that no art rejection was applied against claims 29-31.

#### **Objection**

Claim 29 has been amended as suggest in the Office Action.

#### **Rejections under 35 U.S.C. §§ 101 and 112**

Claims 11-16 and 25-31 were rejected under 35 U.S.C. § 101 allegedly because there is nothing in the claimed system to impart functionality of computer executable codes. Claim 14 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In response, independent claims 11, 25 and 29 have been amended to cure the deficiency. Dependent claims

14, 15, 26, 30, and 31 have been amended to correct matters of form. Accordingly, Applicants believe that the rejections under 35 U.S.C. §101 and §112 have been overcome and respectfully request a withdrawal of the rejections.

**Rejections under 35 U.S.C. § 102(e)**

Claims 11 and 25-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Northington.

Applicants respectfully traverse the rejections.

The present invention is directed to a system and method for a merchant to automatically notify an outside electronic billing vendor (i.e., e-billing vendor) of a change in customer account status when a customer contacts the merchant to change the customer's service (page 1, lines 8-11). In contrast, Northington is directed to a system that automatically consolidates information from a plurality of financial systems into a single system (see Abstract).

MPEP section 2131 states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Northington does not teach or suggest a system (or an application) for merchant to notify an electronic billing vendor of customer status changes as recited in independent claims 11 and 25.

Regarding claim 11, the Examiner asserts that "electronic billing vendor is represented by customer service terminal 120." However, Northington discloses that customer service terminal

120 provides components to access the functionality of the system 100. Northington discloses that a user can submit a request to change information to system 100 using customer service access terminal 120. The system 100 then processes the request and transmits a confirmation signal to customer service terminal 120 (column 13, lines 33-67; and column 14, lines 1-4). Clearly, customer service terminal 120 is not a vendor (i.e., "one that sells" according to Webster's Dictionary). Certainly, customer service terminal 120 is not an e-billing vendor which is "a web-based billing and payment service provider," as defined in page 1, lines 15-16 of the present application.

Additionally, regarding claim 11, since Northington does not teach or suggest the electronic billing vendor, Northington also does not teach or suggest a system including "a communication application module . . . wherein the communication application module transmits the entries through a network from the merchant system to the electronic billing vendor," as recited in the claim.

Further, regarding claim 25, Northington does not teach or suggest an application including "a communication application that transmits the entries to the electronic billing vendor," as recited in the claim.

The Examiner Asserts that "col. 7, L 23-27 [of Northington] . . . in response the data network mover . . . transmits the formatted files to SNA gateways 202 for transfer to the external systems." Northington refers to systems 106 and/or 112 as the "external systems" (column 7, lines 23-27). Northington does not teach or suggest that systems 106 and/or 112 are an e-billing vendor.

Accordingly, Applicants respectfully submit that claims 11 and 25 are not being anticipated by Northington.

Applicants also submit that dependent claims 12-16 are patentable over the references at least for the reasons set forth above with regard to claim 11. Similarly, Applicants submit that dependent claims 26-28 are not being anticipated by Northington at least for the reasons set forth above with regard to claim 25.

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-10 and 12-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Northington in view of Rigole.

Applicants respectfully traverse the rejections for the reasons stated below.

As stated above, Northington does not teach or suggest a method and system for notifying an electronic billing vendor of customer status changes or transmitting entries to the electronic billing vendor.

Additionally, regarding independent claim 1, the references, either individually or in combination, do not teach or suggest at least the following features recited in the claim.

“(b) searching the update file for flagged entries that indicate an account change;” and

“(d) transmitting the reformatted flagged entries that indicate account changes to the electronic billing vendor.”

In the Office Action, in page 8, the Examiner admits that Northington fails to disclose “(a) flagging entries, in an update file . . ., (b) searching the update file for the flagged entries and (c) reformatting the flagged entries.” The Examiner then states that

“Rigole teaches the aforementioned steps of . . . searching the update file for the flagged entries and reformatting the flagged entries in order generate a reformatted

flagged entries. (Refer to paragraph [0048], . . . application data is captured and logged into a server log. . . and may reassign an identifier or key value to the data. . . the identifier could be an indicator of any number of things . . . the logged data may then be parsed . . . that assign items of the raw data into predefined fields in a database . . . , alternatively or simultaneously, the data may be directed by a script or other program into a program module for processing the data)."

As stated in the Office Action, Rigole discloses

- capturing and logging data;
- reassign an identifier to the data;
- parsing the data;
- assigning items of the raw data into predefined fields in a database; and
- alternatively or simultaneously, directing the data by a script or other program into a program module for processing the data.

Rigole, however, does not teach or suggest "searching the update file for flagged entries that indicate an account change," as recited in claim 1.

Further, the Examiner asserts that "Northington discloses transmitting (reporting) entries that indicate account changes to an electronic billing vendor" and that "it would have been obvious to . . . implement the aforementioned steps in Northington method of transmitting . . . ."

As stated above, Northington does not teach or suggest transmitting the entries to the electronic billing vendor. Thus, even if flagging entries and reformatting the flagged entries are implemented to the method disclosed in Northington, the combination still does not teach or suggest "transmitting the reformatted flagged entries that indicate account changes to the electronic billing vendor," as recited in the claim.

Regarding independent claim 17, the references, either individually or in combination, do not teach or suggest at least the following features recited in the claim.

- “(c) flagging the changed services if the changed services involve an electronic billing customer; . . .
- (e) searching the update file for flagged changed services that affect account numbers;
- (f) copying the flagged changed services that affect account numbers into a notification file;
- (g) formatting the notification file into a format used by the electronic billing vendor; and
- (h) making the formatted notification file available to the electronic billing vendor.”

In the Office Action, the Examiner admits that Northington fails to disclose “flagging changed service” and “searching the update file for the flagged changed services.” Since Northington does not teach or suggest “flagging changed service,” in contrast to assertions in page 14 of the Office Action, Northington does not teach or suggest “(f) copying the flagged changed services that affect account numbers into a notification file.”

Further, as stated above, since Northington does not teach or suggest “e-billing vendor,” Northington does not teach or suggest “(g) formatting the notification file into a format used by the electronic billing vendor; and (h) making the formatted notification file available to the electronic billing vendor.”

Also, as stated above, Rigole does not teach or suggest “(e) searching the update file for flagged changed services that affect account numbers.”

Furthermore, in contrast to the assertion in the Office Action, Rigole does not teach or suggest “(c) flagging the changed services if the changed services involve an electronic billing customer.” Rigole discloses that collected data is recorded and may be assigned an identifier.

Rigole, however, does not teach or suggest that the identifier is assigned if the changed services involve an electronic billing customer.

Regarding independent claim 32, the references, either individually or in combination, do not teach or suggest at least the following features recited in the claim.

- “(a) flagging entries in an update file corresponding to electronic billing customers;
- (b) searching the update file for flagged entries that indicate an account change;
- (c) reformatting the flagged entries that indicate account changes;
- (d) transmitting the reformatted flagged entries that indicate account changes to the electronic billing vendor;
- (e) reading account numbers associated with the flagged entries that indicate account changes;
- (f) matching the account numbers to electronic billing account numbers in an electronic billing account database of the electronic billing vendor; and
- (g) updating the electronic billing account numbers with information from the flagged entries that indicate account changes.”

In the Office Action, the Examiner refers to analysis of claim 1 for steps (a)-(d).

Accordingly, as stated above, Rigole does not teach or suggest “(b) searching the update file for flagged entries that indicate an account change,” and the references do not teach or suggest “(c) reformatting the flagged entries that indicate account changes; (d) transmitting the reformatted flagged entries that indicate account changes to the electronic billing vendor.”

The Examiner also states that “steps (e) – (g) are indicated as being performed by ‘end-users’. Steps (e) . . . (f) . . . and (g). . . are inherently indicated as ‘authorized end-users . . . perform maintenance on an account . . . .’.” Applicants respectfully disagree. As stated above, Northington does not teach or suggest a system of notifying an electronic billing vendor of

customer status changes. Rigole also does not teach or suggest a system of notifying an electronic billing vendor of customer status changes. (Rigole discloses a system that allows consumers to select from a variety of different services from a variety of different service providers.) Since neither of the systems disclosed in Northington and Rigole teach or suggest a system of notifying an electronic billing vendor of customer status changes, Applicants respectfully submit that the features recited in steps (e) – (g) of the claim are not inherently indicated as authorized end-users perform maintenance on an account on the system disclosed in either Northington or Rigole. For example, since neither of the references discloses at least “an electronic billing account database of the electronic billing vendor,” “(f) matching the account numbers to electronic billing account numbers in an electronic billing account database of the electronic billing vendor” is not inherently indicated as authorized end-users perform maintenance on an account on the system disclosed in either Northington or Rigole.

Accordingly, Applicants respectfully submit that claims 1, 17 and 32 are patentable over the applied references.

Applicants also submit that dependent claims 2-10 and 18-24 are also patentable over the references at least for the reasons set forth above with regard to the independent claims.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.



Serial No.: 09/531,571  
Art Unit: 3624

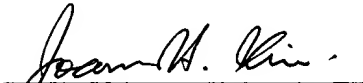
Attorney's Docket No.: BS99-191  
Page 20

SHAW PITTMAN LLP  
1650 Tysons Boulevard  
McLean, VA 22102  
Tel: 703/770-7900

Respectfully submitted,

WILLIAMS ET AL.

Date: January 7, 2004

By:   
Joanne H. Kim  
Registration No. 51,193

Customer No. 28970

JHK/mdd

Document #: 1260630 v.1